



UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/435,544 05/05/95 KNOWLTON

E KNOWL-1501
EXAMINER

HULINA, A

ART UNIT PAPER NUMBER

6

15M2/0403

PAUL DAVIS
HAYNES AND DAVIS
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1501
DATE MAILED:

04/03/96

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 0 days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-35 are pending in the application.
Of the above, claims 1-28 are withdrawn from consideration.
2. ☐ Claims _____ have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 23-35 are rejected.
5. ☐ Claims _____ are objected to.
6. ☒ Claims 1-35 are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-22, drawn to an apparatus for applying radiant energy through the skin, classified in Class 606, subclass 32.

Group II. Claims 23-35, drawn to a method of liposculpturing the body, classified in Class 607, subclass 101.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (M.P.E.P. § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as heating tumor bearing tissue.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Paul Davis on 3-4-96 a provisional election was made without traverse to prosecute the invention of II, claims 23-35. Affirmation of this election

must be made by applicant in responding to this Office action.

Claims 1-22 are withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

5. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

6. Claims 22-35 are rejected under 35 U.S.C. § 103 as being unpatentable over Fellner in view of Storm, III (Storm).

Fellner discloses a method of controlling obesity in a human subject by non-invasively eliminating excess healthy adipose tissue from a subcutaneous adipose tissue layer comprising focusing radiant energy, such as radio frequency energy via contact electrodes, on the excess adipose cells for a time sufficient to cause destruction of said cells.

Storm discloses an electrode structure for use in emitting electromagnetic radiation for localized heating of tissue in

medical therapy and capable of permitting deep heat penetration while skin surfaces and subcutaneous tissue remain at lower and physiologic temperatures not harmful to living tissue. A thin flexible pliant bag filled with electrolyte solution and placed between the skin surface and the electrode means can be used to increase surface contact on very irregular skin surfaces (col. 2, lines 62-68). The electrode means is connected to a power source. The flexible bag has inlet and outlet fittings for cooling fluid (col. 4, lines 10-16). The electrode means of the invention provides regulation and control of superficial heating of normal living tissue while permitting the application of electromagnetic radio frequency heating at relatively great depths of tumor bearing tissue or otherwise diseased tissue in a body.

It would have been obvious to one having ordinary skill in the art to use the electrode means disclosed by Storm to remove adipose tissue as disclosed by Fellner and to adjust the cooling means so that the skin surface is not burned.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Hulina whose telephone number is (703) 308-2974.

Amy Hulina
Amy Hulina
Patent Examiner
Art Unit 1501

AH
April 1, 1996